

Appl. No. 10/790,418
Atty. Docket No. 9562
Amdt. dated 10/20/2005
Reply to Office Action of 7/21/2005
Customer No. 27752

REMARKS

Claim Status

Claims 1-20 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has been amended to add the element of a pressure sensitive adhesive. Support for the amendment is found at page 3, lines 12-13 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §102 Over Dobrin, US 5,843,066

Claims 1-5, 7-8, and 11-14 have been rejected under 35 USC §102(b) as being anticipated by Dobrin, US 5,843,066.

Applicants respectfully traverse the rejection. Claim 1 has been amended to recite the sanitary napkin having a "garment-facing side" and "wherein said garment-facing side has thereon pressure sensitive adhesive for affixing to a wearer's undergarment."

Dobrin does not teach, disclose, or otherwise suggest the limitation of a pressure sensitive adhesive on a garment-facing side of a sanitary napkin.

Accordingly, the Applicants submit Claim 1 and its dependent claims are novel and respectfully request the rejection be withdrawn.

Rejection Under 35 USC §103(a) Over Dobrin, US 5,843,066 in view of Ahr, US 5,800,418.

Claims 6, 10, and 16-19 have been rejected under 35 USC §103(a) as being unpatentable over Dobrin, US 5,843,066 in view of Ahr, US 5,800,418.

Applicants respectfully submit the Office Action fails to make a *prima facie* case of obviousness. See, MPEP 2143.

A rejection of the present invention under 35 U.S.C. §103 must comport with the standard set forth in *Graham v. John Deere Company* 383 US1, 148 USPQ 459 (1966), explained in MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must

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- (1) Set forth the differences in the claims over the applied references;
- (2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (3) Explain why the proposed modification would be obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch*, 922 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

In this case, the examiner provides no basis for a proposed modification of the diaper of Dobrin to be modified by any of the disclosure of Ahr that might relate to sanitary napkins. Rather than propose *why* the modification *would be* obvious, the Examiner simply restates the claimed invention as if the combination were obvious. What is missing is any reason in Dobrin, for example, of the desirability to be modified.

The Examiner, having allegedly found all the pieces of the invention (of original Claim 1) in two references, simply stated without basis, that "It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Dobrin's invention [i.e., DIAPER] by Ahr's [invention? ABSORBENT CORE?] to produce a highly absorbent core composed of both ..." (OA, page 4).

Dobrin's disclosure is unambiguously teaching a disposable diaper. All the description including the drawings and the claims is directed to a disposable diaper. Why would one skilled in the art of diapers, looking to the diaper disclosure of Dobrin be motivated to modify the diaper of Dobrin to have the core of Ahr, and additionally make all the other changes to achieve the claimed sanitary napkin of the invention?

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The Examiner provides no insight into why the skilled person might do all the modifications described above. Why, for example, would the skilled person wish to put an oval-shaped core into the diaper of Dobrin? The reference itself (Dobrin) certainly provides no teaching or suggestion that such a modification might be beneficial. The same argument could be made for all the supposed-obvious modifications suggested not by the references, but by the Examiner.

In short, there is no teaching in Dobrin to be modified to be a sanitary napkin. Furthermore, there is no teaching or suggestion in Dobrin to be modified to have pressure sensitive adhesive on a garment-facing side. Ahr teaches an absorbent core. Simply combining Ahr with Dobrin achieves a diaper of Dobrin with the core of Ahr. Even if one makes this combination, one does not achieve the claimed invention.

Accordingly, Applicants respectfully submit the Examiner has not made a prima facie case of obviousness, and the rejection should be withdrawn.

Rejection Under 35 USC §103(a) Over Dobrin, US 5,843,066 in view of Ahr, US 5,800,418, and further in view of Melius, US 6,646,179.

Claim 20 has been rejected under 35 USC §103(a) as being unpatentable over Dobrin, US 5,843,066 in view of Ahr, US 5,800,418, and further in view of Melius, US 6,646,179.

The arguments above with respect to Claims 6, 10, and 16-19 are incorporated by reference here of the purpose of showing the insufficiency of Dobrin and Ahr to render obvious any portion of the claimed invention.

Applicants respectfully submit the Office Action fails to make a prima facie case of obviousness. See, MPEP 2143. The addition of Melius fails to remedy the deficiencies of Dobrin and Ahr in rendering the claimed invention obvious.

A rejection of the present invention under 35 U.S.C. §103 must comport with the standard set forth in *Graham v. John Deere Company* 383 US1, 148 USPQ 459 (1966),

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explained in MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must

- (1) Set forth the differences in the claims over the applied references;
- (2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (4) Explain why the proposed modification would be obvious.

To satisfy Step (3), the Patent Office must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). See *In re Jones*, 958 F2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Patent Office does not make the modification obvious unless the prior art suggests the desirability of the modification. See *In re Fritch*, 922 F2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992).

In this case, as shown above, there is no motivation to modify Dobrin to be a sanitary napkin of any type, much less the claimed sanitary napkin. The addition of Ahr did not provide any additional motivation to make the diaper of Dobrin into a sanitary napkin, and the addition of Melius on top of the already-deficient references does nothing to render Claim 20 obvious.

The rejection of Claim 20 appears to be a piece-meal combination of disparate parts of references that *can* be combined, but are impermissibly applied unless the art suggests the combination.

The Examiner gave as a reason, "It would have been obvious ... to provide an absorbent article with a sufficient amount of absorbent core to receive bodily fluids."

However, Dobrin already disclosed such an absorbent core. There is no motivation in Dobrin to be modified with a "sufficient amount of absorbent core." The Examiner has not identified any portion of Dobrin in which Dobrin expresses a desire for some other core to be able to have a "sufficient amount."

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Further, there is no suggestion in Ahr that the core of Ahr is in any not "sufficient." Indeed, the entire disclosure of Ahr is for a core that is "sufficient." The Examiner fails to identify any motivation to make Ahr any more sufficient, much less any motivation to combine with the already sufficient core of Dobrin were one to do so.

Applicants respectfully submit that this hindsight rejection of Claim 20 be withdrawn, at least until the Examiner can fulfill the requirements of a prima facie case of obviousness and explain why the proposed modifications or at least be provided with reasons why the proposed modifications are obvious, rather than simply state they are.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-20 is respectfully requested.

Respectfully submitted,

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By


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